

## §41.7

## 37 CFR Ch. I (7–1–11 Edition)

(b) *Record of proceeding.* (1) The record of a Board proceeding is available to the public unless a patent application not otherwise available to the public is involved.

(2) Notwithstanding paragraph (b)(1) of this section, after a final Board action in or judgment in a Board proceeding, the record of the Board proceeding will be made available to the public if any involved file is or becomes open to the public under §1.11 of this title or an involved application is or becomes published under §§1.211 to 1.221 of this title.

### §41.7 Management of the record.

(a) The Board may expunge any paper directed to a Board proceeding, or filed while an application or patent is under the jurisdiction of the Board, that is not authorized under this part or in a Board order, or that is filed contrary to a Board order.

(b) A party may not file a paper previously filed in the same Board proceeding, not even as an exhibit or appendix, without Board authorization or as required by rule.

### §41.8 Mandatory notices.

(a) In an appeal brief (§§41.37, 41.67, or 41.68) or at the initiation of a contested case (§41.101), and within 20 days of any change during the proceeding, a party must identify:

- (1) Its real party-in-interest, and
- (2) Each judicial or administrative proceeding that could affect, or be affected by, the Board proceeding.

(b) For contested cases, a party seeking judicial review of a Board proceeding must file a notice with the Board of the judicial review within 20 days of the filing of the complaint or the notice of appeal. The notice to the Board must include a copy of the complaint or notice of appeal. See also §§1.301 to 1.304 of this title.

### §41.9 Action by owner.

(a) *Entire interest.* An owner of the entire interest in an application or patent involved in a Board proceeding may act in the proceeding to the exclusion of the inventor (see §3.73(b) of this title).

(b) *Part interest.* An owner of a part interest in an application or patent in-

volved in a Board proceeding may petition to act in the proceeding to the exclusion of an inventor or a co-owner. The petition must show the inability or refusal of an inventor or co-owner to prosecute the proceeding or other cause why it is in the interest of justice to permit the owner of a part interest to act in the proceeding. An order granting the petition may set conditions on the actions of the parties during the proceeding.

### §41.10 Correspondence addresses.

Except as the Board may otherwise direct,

(a) *Appeals.* Correspondence in an application or a patent involved in an appeal (subparts B and C of this part) during the period beginning when an appeal docketing notice is issued and ending when a decision has been rendered by the Board, as well as any request for rehearing of a decision by the Board, shall be mailed to: Board of Patent Appeals and Interferences, United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450. Notices of appeal, appeal briefs, reply briefs, requests for oral hearing, as well as all other correspondence in an application or a patent involved in an appeal to the Board for which an address is not otherwise specified, should be addressed as set out in §1.1(a)(1)(i) of this title.

(b) *Contested cases.* Mailed correspondence in contested cases (subpart D of this part) shall be sent to Mail Stop INTERFERENCE, Board of Patent Appeals and Interferences, United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450.

### §41.11 *Ex Parte* communications in *inter partes* proceedings.

An *ex parte* communication about an *inter partes* reexamination (subpart C of this part) or about a contested case (subparts D and E of this part) with a Board member, or with a Board employee assigned to the proceeding, is not permitted.

### §41.12 Citation of authority.

(a) Citations to authority must include:

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(1) *For any United States Supreme Court decision*, a United States Reports citation.

(2) *For any decision other than a United States Supreme Court decision*, parallel citation to both the West Reporter System and to the United States Patents Quarterly whenever the case is published in both. Other parallel citations are discouraged.

(3) *Pinpoint citations* whenever a specific holding or portion of an authority is invoked.

(b) Non-binding authority should be used sparingly. If the authority is not an authority of the Office and is not reproduced in one of the reporters listed in paragraph (a) of this section, a copy of the authority should be filed with the first paper in which it is cited.

EFFECTIVE DATE NOTE: At 73 FR 32973, June 10, 2008, § 41.12 was revised, effective December 10, 2008. Per a subsequent final rule published at 73 FR 74972, Dec. 10, 2008, the effective date of this action was delayed indefinitely. For the convenience of the user, the revised text is set forth as follows:

### **§ 41.12 Citation of authority.**

(a) *Authority*. Citations to authority must include:

(1) *United States Supreme Court decision*. A citation to a single source in the following order of priority: United States Reports, West's Supreme Court Reports, United States Patents Quarterly, Westlaw, or a slip opinion.

(2) *United States Court of Appeals decision*. A citation to a single source in the following order of priority: West's Federal Reporter (F., F.2d or F.3d), West's Federal Appendix (Fed. Appx.), United States Patents Quarterly, Westlaw, or a slip opinion.

(3) *United States District Court decision*. A citation to a single source in the following order of priority: West's Federal Supplement (F.Supp., F.Supp. 2d), United States Patents Quarterly, Westlaw, or a slip opinion.

(4) *Slip opinions*. If a slip opinion is relied upon, a copy of the slip opinion must accompany the first paper in which an authority is cited.

(5) *Pinpoint citations*. Use pinpoint citations whenever a specific holding or portion of an authority is invoked.

(b) *Non-binding authority*. Non-binding authority may be cited. If non-binding authority is not an authority of the Office and is not reproduced in one of the reporters listed in paragraph (a) of this section, a copy of the authority shall be filed with the first paper in which it is cited.

### **§ 41.20 Fees.**

(a) *Petition fee*. The fee for filing a petition under this part is \$400.00.

(b) *Appeal fees*. (1) For filing a notice of appeal from the examiner to the Board:

By a small entity (§ 1.27(a) of this title) .....	\$270.00
By other than a small entity .....	\$540.00

(2) In addition to the fee for filing a notice of appeal, for filing a brief in support of an appeal:

By a small entity (§ 1.27(a) of this title) .....	\$270.00
By other than a small entity .....	\$540.00

(3) For filing a request for an oral hearing before the Board in an appeal under 35 U.S.C. 134:

By a small entity (§ 1.27(a)) .....	\$540.00
By other than a small entity .....	\$1,080.00

[69 FR 50003, Aug. 12, 2004, as amended at 69 FR 52606, Aug. 27, 2004; 69 FR 55506, Sept. 15, 2004; 69 FR 56546, Sept. 21, 2004; 70 FR 3892, Jan. 27, 2005; 72 FR 46903, Aug. 22, 2007; 73 FR 47542, Aug. 14, 2008]

## **Subpart B—Ex Parte Appeals**

### **§ 41.30 Definitions.**

In addition to the definitions in § 41.2, the following definitions apply to proceedings under this subpart unless otherwise clear from the context:

*Applicant* means either the applicant in a national application for a patent or the applicant in an application for reissue of a patent.

*Owner* means the owner of the patent undergoing *ex parte* reexamination under § 1.510 of this title.

*Proceeding* means either a national application for a patent, an application for reissue of a patent, or an *ex parte* reexamination proceeding. Appeal to the Board in an *inter partes* reexamination proceeding is controlled by subpart C of this part.

EFFECTIVE DATE NOTE: At 73 FR 32973, June 10, 2008, § 41.30 was amended by adding a definition for "Record", effective December 10, 2008. Per a subsequent final rule published at 73 FR 74972, Dec. 10, 2008, the effective date of this action was delayed indefinitely.